



12-1605

JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Janzen Lo, et al.

Serial No.: 10/791,050

Group Art Unit: 3733

Filed: 03-02-04

Examiner: KIM, John

For: SPINAL IMPLANTS

Attorney Docket No.: 2186.00060

**RESPONSE**

Mail Stop: Response  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This response is being submitted in response to an Office Action dated November 15, 2005, Paper Number 11032005. According to the Office Action, restriction to one of the following Groups is required under 35 USC §121:

I. Claims 1-12, 13-23, 24-34, and 35-36 are drawn to a spinal implant, classified in class 623, subclass 17.11; and

II. Claims 37-38, 39, and 40-41 are drawn to a method of making a spinal implant, classified in class 424, subclass 549.

Applicants provisionally elect with traverse Group I, which is directed towards claims 1-36, for prosecution purposes. Applicants hereby conditionally withdraw claims 37-41 from prosecution, without prejudice, and request reconsideration of the restriction requirement.

Applicants traverse the restriction requirement based on the following grounds. It is respectfully submitted that the restriction requirement practice was established to promote efficiency of prosecution in the United States Patent Office. Both groups of claims relate to a bone implant and methods related to manufacturing the implants. It is a well accepted practice in the United States Patent Office to claim a device and methods of manufacturing the devices in the same application and without restriction. Accordingly, Applicants believe it is entirely reasonable and would not present an undue burden on the Patent Office, for the claims of both groups to be prosecuted together in the same instant application. It is respectfully submitted that examination of all of these groups of claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice. Hence, it is respectfully submitted that restriction should not be required and that Applicants have traversed the restriction requirement. However, as stated above, Applicants provisionally elect claims 1-36 of Group I and provisionally withdraw claims 37-41, pending reconsideration of the restriction requirement.

The Office Action also states that Applicants are further required under 35 U.S.C. §121 to elect a single disclosed species to which the claims would be restricted if no generic claim is finally held allowable and to list all claims readable thereon including those subsequently added. Since claims 1-36 of Group I have been elected by Applicants, Applicants elect the species disclosed in Figure 2. Applicants elect the above species without traverse.

The present application is now in condition for allowance, which allowance is respectfully requested.

The Commissioner, is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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Dated: December 14, 2005

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop: Response, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Connie Herty